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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/707,433	11/07/2000	Bruce K. Geist	PM021	9716

7590

07/21/2005

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EXAMINER

ZAND, KAMBIZ

ART UNIT	PAPER NUMBER
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2132

DATE MAILED: 07/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.

09/707,433

Applicant(s)

GEIST ET AL.

Examiner

Kambiz Zand

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 May 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 29-144 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 29-64, 72-85, 92-127 and 133-144 is/are rejected.
- 7) ☒ Claim(s) 65-71, 86-91 and 128-132 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

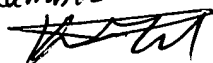
Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Kambiz Zand


Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The text of those sections of Title 35, U.S. Code not included in this section can be found in the prior office action.
2. The prior office actions are incorporated herein by reference. In particular, the observations with respect to claim language, and response to previously presented arguments.
3. Claim 1-28 have been cancelled.
4. Claims 136 and 141-144 have been amended.
5. Claims 29-144 are pending.
6. Examiner withdraws objection to the specification due to correction by the applicant.
7. Examiner withdraws rejection of claim 1 under 35 U.S.C 112-second paragraphs due to cancellation of the claim by the applicant.

Response to Arguments

8. Applicant's arguments filed 05/16/2005 have been fully considered but they are not persuasive.
 - As per applicant's arguments traversing examiner objections to claims 29-144 for the use of the phrase "critical" are not persuasive based on following examiner's remarks:
 - a) Page 15, lines 15-19 of the Applicant's specification defines "critical document data" as "personal value document having digital signature".

b) page 16, lines 25-29 of the applicant's specification disclose that "critical document data" may not necessary have a access digital signature.

Therefore it is not clear if "critical document data" have digital signature or not, further more one of the ordinary skilled in the art would not define "critical document data" necessary having an embedded digital signature. In a broadest term and as an example a social security digital document could be considered as a "critical document data".

Examiner suggest "document data having a digital signature" as an option in harmony with applicant's arguments and page 15 of the specification.

- In response to applicant's argument with respect to claims 29-64, 72-85, 92 and 100-108 that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e. " **identical** public/private key pair" emphasized added) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).
- As per applicant's arguments that Gordon do not teach "the public key certificate, including the authentic public key, is stored on the self-authenticating document", examiner makes the following remarks:

Col.6, lines 53-54 disclose "need not include the public key with the value message" as it has pointed out by applicant in support of Applicant's arguments above,

however the phrase only disclose such inclusion is not necessary, and that is an option and not the only solution.

Further more the recitation directed to the manner in which a claimed apparatus is intended to be used does not distinguish the claimed apparatus from the prior art if prior art has the capability to do so perform (See MPEP 2114 and Ex Parte Masham, 2 USPQ2d 1647 (1987)).

- As per applicant's arguments with respect to claims 93-99, 109-118, 119-127 and 133-139, please see above arguments and the followings:

Further more the recitation directed to the manner in which a claimed apparatus is intended to be used does not distinguish the claimed apparatus from the prior art if prior art has the capability to do so perform (See MPEP 2114 and Ex Parte Masham, 2 USPQ2d 1647 (1987)).

Claim Rejections - 35 USC § 102

9. **Claims 1, 29-37, 39-51, 53-64, 72-85, 92-127 and 133-144** are rejected under 35 U.S.C. 102(e) as being anticipated by Gordon et al. (6,289,323 B1).

As per claim 1 Gordon et al. (6,289,323 B1) disclose constructing a data string (see fig.2; col.4, lines 9-11); generating a digital signature based on the data string and a private key (see col.4, lines 34-40); obtaining a public key certificate from a certifying authority (see col.6, lines 44-54); and fixing at least some of the data string, the first digital signature and the public key certificate to the document (see fig.2; col.3-15).

As per claims 29-31, 37, 43-44, 48, 51, 60, 64, 75, 81, 93, 94, 100, 102, 103, 104, 106-109, 111-113, 115-119, 121-124 and 133-144 Gordon et al. (6,289,323 B1) disclose a first digital signature (encrypting over a digest using private key) (see fig.2; col.4, lines 9-43); a second digital signature (encrypting over a digest using private key) (see fig.2; col.4, lines 43-52) and a personal identification number (pin) (see col.4, lines 18-21); and a public key certificate including an authentic public key for validating said first and second digital signature (see fig.2; col.5, lines 4-14), wherein said first, second digital signature and said public key certificate are stored on said self-authenticating document (see fig.2; col.4, lines 9-67; col.5, lines 1-22). Gordon further teach bar code reader and data contained in a magnetic ink character recognition code line where the above information are stored in a bar code reader and all limitation set forth in the above claims (see col.4, lines 24-30, 55-57 and 65-67; col.5, lines 1-14; also see col.5-15). Also see col.3-15 for detailed.

As per claims 32, 33, 49, 50, 77, 78, 95, 101, 110 and 120 Gordon et al. (6,289,323 B1) disclose ASCII text that includes account name and address (see col.3-6; also ASCII is inherent within the bar code readers and scanners).

As per claims 34-36, 45-47, 76, 96 and 97 Gordon et al. (6,289,323 B1) disclose said document is a personal value/ commercial value such as personal check, identification card, SS number, credit card, passport, driver license, birth certificate, voter's

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registration card, bank check, business check, tickets, gift certificate, titles, currency, etc (see fig.7; col.2, lines 5-10; col.3-6 line11).

As per claims 39-42, 53-56, 79, 80, 98 and 99 Gordon et al. (6,289,323 B1) disclose a barcode format includes number of fields as recited in the above claims (see fig.2; col.4, lines 23-67; col.5, lines 1-14; col.6, lines 18-67; col.7, lines 36-52; col.8, lines 1-62).

As per claims 57 and 84 Gordon et al. (6,289,323 B1) disclose personal identification number is selected by the owner of said personal value document (see fig.7).

As per claims 58, 59, 62, 72-74, 85, 92 and 125-127 Gordon et al. (6,289,323 B1) disclose a third party responsible for printing and issuing said personal value document selects said personal identification number (see fig.7 for issuing and fig.9 for printing; col.3-15).

As per claims 61, 63, 82, 83, 105 and 114 Gordon et al. (6,289,323 B1) disclose said digital signature algorithm is an elliptic curve digital signature algorithm (ECDSA) (see col.6, lines 33-45).

Claim Rejections - 35 USC § 103

10. Claims 38 and 52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gordon et al. (6,289,323 B1) in view of Axelord et al (5,337,358 A).

As per claims 38 and 52 Gordon et al. (6,289,323 B1) disclose all limitation of the claims but do not disclose explicitly bar code format is PDF 417. However Axelord et al (5,337,358 A) disclose PDF-417 (see col.3, lines 31-35). It would have been obvious to one ordinary skilled in the art at the time the invention was made to utilize Axelord's PDF-417 in Gordon's barcode system in order to record a transaction including authentication of an identification card.

Allowable Subject Matter

11. Claims 65-71, 86-91 and 128-132 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

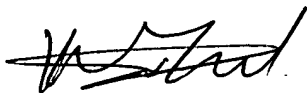
12. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kambiz Zand whose telephone number is (571) 272-3811. The examiner can normally be reached on Monday-Thursday (8:00-5:00). If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron can be reached on (571) 272-3799. The fax phone numbers for the organization where this application or proceeding is assigned are (571) 273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Kambiz Zand

07/19/2005

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